Appl. No.: 09/402,232
Grp./A.U. 1623

REMARKS/ARGUMENTS

Favorable consideration and allowance of the instant application is respectfully requested in view of the following remarks.

Claims 25-37 are pending in this application.

Claim 25 has been amended for purposes of clarity. No new matter is believed to be added thereby.

The Examiner's rejections, as they pertain to the patentability of the claims, are respectfully traversed.

Claims 25-37 are rejected under 35 U.S.C. § 112, first paragraph. This rejection is respectfully traversed for the following reasons.

Claim 25 has been amended in order to correct a previously omitted typographical error. Accordingly, reconsideration and withdrawal of this objection is respectfully requested.

Claims 25-32 and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over McCurry et al. (US 4,950,743). This rejection is respectfully traversed for the following reasons.

Initially, Applicant would like to note that it is extremely well settled that in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure [underline emphases added]. See, *Manual of Patent Examining Procedure*, Rev. 3, July 1997, § 2142, pages 2100-108.

Applicant respectfully submits that the '743 reference fails to render the claimed

invention prima facie obvious on the grounds that it fails to teach or suggest **many** of the claimed elements of the present invention. Specifically, the '743 reference fails to teach or suggest: (1) the use of the claimed glucose sirup; (2) the use of the claimed **preheated** fatty alcohol used to form the claimed suspension; (3) the addition of acid catalyst to the glucose sirup/fatty alcohol suspension prior to drying; and (4) **the claimed acetalization temperature gradient.**

The Examiner now contends, among other things, that because McCurry fails to recite the temperature of its suspension, it is presumed to be room temperature and, as a result, this qualifies as "preheating"; see Paper No. **24**, page 3. Applicant is at a loss in trying to understand how something at room temperature can be thought of as being preheated. As a result, clarification and evidence based on fact and/or technical reasoning in support of this contention is respectfully requested.

The Examiner then goes on to contend in Paper No. **24**, page 4, that the artisan would be motivated to use the claimed glucose sirup in the form of an aqueous solution, using preheated alcohol, in order to facilitate mixing of the initial suspension. Unfortunately, this teaching does not appear anywhere within the four corners of the McCurry reference. Rather, the Examiner is merely formulating an opinion as to why the routineer may choose to do so. This being the case, Applicant would like to note that it has been held that, "The Patent Office ... may not, because it may **doubt** that the invention is patentable, resort to speculation, unfounded assumptions or hindsight to supply deficiencies in its factual basis." See, In re Warner, 154 USPQ 173, 178 (CCPA 1967).

The fact of the matter remains that this reference fails to teach or suggest the above-enumerated elements of the claimed invention. Consequently, it should not serve to render the claimed invention prima facie obvious.

The Examiner also appears to be trying to shift the burden of proof onto the Applicant to show it would not be obvious to the routineer to employ the above-enumerated

claim limitations in the McCurry reference. Unfortunately, unless and until the Examiner discharges his initial burden of proof by way of a **factual** showing as to why it would be obvious to the routineer to employ the claimed limitations in view of McCurry's teaching, Applicant is not obligated to prove the Examiner wrong. It is well settled in the law that the mere allegation that the differences between the claimed subject matter and the prior art are obvious does not create a presumption of unpatentability which forces an Applicant to prove conclusively that the Patent Office is wrong. See, In re Soli, 137 USPQ 797 (CCPA 1963). Consequently, since nothing contained in Paper No. **24** qualifies as facts and/or technical reasoning sufficient to satisfy the Examiner's burden of proof in establishing the obviousness of the present invention in view of the teachings of the '743 reference, Applicant respectfully submits that the claimed invention is therefore patentable over its teachings.

Accordingly, for all of the above-stated reasons, reconsideration and withdrawal of this rejection is respectfully requested.

Claims 26, 29 and 33-36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over McCurry et al. (US 4,950,743), in view of Grutzke et al. (US 5,648,475). This rejection is respectfully traversed for the following reasons.

The shortcomings associated with the teaching of the McCurry reference are as outlined above, and **admitted to** by the Examiner. The Grutzke reference is cited merely for its alleged teaching concerning the use of a cascade of reactors. However, it is respectfully submitted that regardless of whether the teaching of the '475 reference relating to the use of a cascade of reactors is obvious or not, since neither reference, **alone or in combination**, teaches or suggests **all of the claim limitations of the present invention**, a prima facie case of obviousness would nevertheless fail to be established against the claimed invention. See, *MPEP*, section 2142, pages 2100-108.

Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

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It is believed that the foregoing reply is completely responsive under 37 CFR 1.111 and that all grounds for rejection are completely avoided and/or overcome. A Notice of Allowance is therefore earnestly requested.

The Examiner is requested to telephone the undersigned attorney if any further questions remain which can be resolved by a telephone interview.

Respectfully submitted,

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